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Paper No. 8

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OCT 25 2002

OFFICE OF PETITIONS

In re Application of
Yan et al.
Application No. 10/090,002
Filed: March 5, 2002
Attorney Docket Number: CL001316

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is in response to the renewed petition under 37 CFR §1.47(a), filed October 1, 2002.

The petition is **dismissed**.

Rule 47 applicant is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR §1.47(a)," and should address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR §1.136(a).

The above-identified application was filed on March 5, 2002, without a signed oath or declaration and naming Chunhua Yan and Fangcheng Gong as co-inventors.

Accordingly, on April 1, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring the basic filing fee, claim fees, an executed oath or declaration and a \$130.00 surcharge for its late filing.

In response, on July 1, 2002, applicant submitted the basic filing fees, claim fees, a \$130.00 surcharge for late filing oath or declaration fee, and a copy of a returned certified mail envelope to inventor Gong. Pursuant to applicants' request the \$130.00 petition fee was charged to deposit account 50-0970. A petition under 37 CFR 1.47(a) was dismissed for not submitting a one month extension of time.

On renewed petition, petitioner contends a fee transmittal submitted on July 1, 2002 authorized the PTO to charge any additional fees required under 37 CFR 1.16 and 1.17. A review of the Office record does not show a copy of the July 1, 2002 fee transmittal form. Nonetheless petitioner will be charged the one (1) month \$110.00 extension of time fee based upon the July 1, 2002 fee transmittal form.

A grantable petition under 37 CFR §1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the

petition fee; and, (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) as set forth above.

As to item (1), rule 47 applicant has failed to demonstrate "diligent effort" was used to locate inventor Gong. See MPEP 409.03(d). The statement of facts indicates applicant tried to contact inventor Gong via e-mail and certified mail. However, the e-mail correspondence went unanswered and the communication sent via certified mail to inventor Gong's last known address was returned "attempted not known". One certified letter to inventor Gong at his last known address does not constitute "diligent effort" Did rule 47 applicant contact known colleagues for a forwarding address of inventor Gong? Was an electronic search conducted to locate the last known address? Did rule 47 applicant look in the phone book for a listing of inventor Gong? Applicant may wish to conduct an Internet search and contact a Fangcheng Gong in West Lafayette, Indiana 47906, who may be the inventor involved with the above-identified application. If Fangcheng Gong in Indiana is the inventor for this application, rule 47 applicant is required to send a copy of application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See MPEP 409.03(d).

Should additional searches for inventor Gong not yield any results, applicant should present copies of documentary evidence that support a finding that the non-signing inventor could not be found or reached and the steps taken to locate the non-signing inventor. If applicant provides sufficient evidence that diligent effort has been made to locate the inventor and inventor can not be located, 47 applicant is not required to send a copy of the application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
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Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

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